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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,074	03/13/2001	Stephen Johnson	TPP31729	9099
7590 Stephen Gigante, Esq. c/o Cha & Reiter #103 210 Route 4 East Paramus, NJ 07652			EXAMINER SIDDIQI, MOHAMMAD A	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 06/12/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/804,074

Applicant(s)

JOHNSON ET AL.

Examiner

Mohammad A. Siddiqi

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02/12/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

**DETAILED ACTION**

1. Claims 1-14 and 16-65 are presented for examination. Claim 15 has been canceled.
2. In view of the Appeal Brief filed on 02/12/2007, have been fully Considered and are persuasive, PROSECUTION IS HEREBY REOPENED.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Independent claims 17, 23, 41, and 53 and their dependent claims are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The web browser, a graphical collaboration tool, and server process are software constructs (software per se) performing various functionalities. These

functionalities do not manipulate any hardware or tangible entity. Therefore, these software constructs are non statutory entities as detailed in MPEP 2106.

5. Independent claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result. The claimed subject matter does not produce useful practical application. Therefore claim 23 is non statutory entities as detailed in MPEP 2106.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of

paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims rejected 1-14, 16-65 are under 35 U.S.C. 102(e) as being anticipated by Rivette et al. (6,877,137) (hereinafter Rivette).

8. As per claims 1 and 23, Rivette discloses a computer-implemented method of network collaboration through embedded annotation and rendering instructions to generate, transmit, and render collaborative content, the method comprising the steps (col 7, line 45 to col 8, line-31) of: generating by an originator client workstation (Chef is originator and must be using work station, col 11, lines 17-30) a collaborative content including a base document (recipe is send by e-mail, col 11, lines 17-30) having a document identifier (URL col 11, lines 17-30) that identifies a location of a content (URL col 11, lines 17-30); and at least one collaborative content element (col 11, lines 17-30) at least one annotation therein and rendering instruction therefore so as to annotate said base document by embedding (adds a new note, col 11, lines 17-30) said at least one annotation and instructions therefore as an encoded representation of collaborative content and forwarding the collaborative content to a server for execution (uses a present invention to send this new sets of notes to other chef, fig 5-7I, col 11, lines 17-30, lines 40-65 );

rendering by a server said collaborative content element to said base document in accordance with rendering instruction (fig 5-7I, col 11, lines 17-30, lines 40-65), and providing said collaborative content to said originator client workstation for display fig 5-7I, col 11, lines 17-65).

9. As per claims 2 and 24, Rivette discloses further comprising the steps of: annotating said collaborative content (col 10, lines 6-21) by adding another collaborative content element (new color, col 10, lines 13-21; col 11, lines 17-65).

10. As per claims 3 and 25, Rivette discloses wherein said annotating step comprises presenting annotation options to said client workstation (figs. 5-7I, col 11, lines 17-65).

11. As per claims 4 and 26, Rivette discloses wherein said annotating step comprises inputting a text element to name said collaborative content element ("Customer feedback", figs. 5-7I, col 11, lines 17-65).

12. As per claims 5 and 27, Rivette discloses wherein said annotating steps comprises inputting at least one of a symbol, shape and a text input

element to generate text as said collaborative element ("Customer feedback", figs. 5-7I, col 11, lines 17-65).

13. As per claims 6 and 28, Rivette discloses wherein said annotating steps comprises providing a visual cue to indicate the state of said collaborative content (a new color, figs. 5-7I, col 11, lines 17-65).

14. As per claims 7 and 29, Rivette discloses wherein said visual cue comprises at least one of a marker, cursor, icon, and marquee box (figs. 5-7I, col 11, lines 17-65).

15. As per claims 8 and 30, Rivette discloses wherein said transmitting step is initiated by a user selecting a visual element to transmit said collaborative content subsequent to said collaborative content being saved (col 3, lines 38-50; col 11, lines 55-65, Note engine manages notes and it enables user to create, modify and delete).

16. As per claims 9 and 31, Rivette discloses wherein said client workstation includes at least one of a personal computer equipped with internet browser software (col 12, lines 33-49), a mobile communication

device with a graphical or textual display, and a personal digital assistant equipped with a hypertext viewer (figs. 5-7I, col 11, lines 17-65).

17. As per claims 10 and 32, Rivette discloses wherein said client workstation includes a program execution capability comprising: an Interpreted software program (Javascript, col 12, lines 33-49); a compiled software program (JavaScript, col 12, lines 33-49); and a software program executed by a virtual machine (JavaScript, col 12, lines 33-49).

18. As per claims 11 and 33, Rivette discloses wherein said transmitting step is performed using a messaging system (e-mail, col 11, lines 17-30).

19. As per claims 12 and 34, Rivette discloses wherein said messaging system includes at least one of:  
an electronic mail system (col 11, lines 17-30); an  
electronic news or bulletin-board system (col 11, lines 17-30); and a mobile paging system (col 11, lines 17-30).

20. As per claims 13 and 35, Rivette discloses wherein said transmitting step is performed using a transport mechanism including at least one of:



an internet protocol (web, fig 8);  
a wireless protocol (web, fig 8);  
a synchronous messaging protocol (fig 8); and  
an asynchronous messaging protocol (fig 8).

21. As per claims 14, 36, and 37, Rivette discloses wherein said network is a peer-to-peer network, and the rendering step is performed on a server portion of said originator client workstation in said peer-to-peer network (fig 6, col 15, lines 25-46).

22. As per claim 16, Rivette discloses wherein the collaborative content transmitted in said transmitting step includes a URL and rendering instructions (col 11, lines 17-30).

23. As per claim 38, Rivette discloses the collaborative content transmitted includes a URL comprising the embedded annotation and rendering instructions (col 11, lines 17-30).

24. As per claim 39, Rivette discloses wherein said sequences of instructions include at least one of a client-side scripting language (col 12, lines 32-49).

25. As per claim 40, Rivette discloses wherein said sequences of instructions include at least one of Javascript and dynamic HTML (col 12, lines 32-49).

26. As per claim 17, claim is rejected for the same reasons as claim 1, above. In addition, Rivette discloses a web browser software for displaying a collaborative content (browser, figs. 5-7I, col 11, lines 17-65) in accordance with rendering instructions therefor, said collaborative content including a base document (figs. 5-7I, col 11, lines 17-65)

generating at least one collaborative content element on the collaborative content displayed in said web browser software and transmitting the at least one collaborative content element (figs. 5-7I, col 11, lines 17-65).

27. As per claim 18, Rivette discloses wherein said graphical collaboration tool includes a toolbar (fig 43).

28. As per claim 19, Rivette discloses wherein said toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (fig 43).

29. As per claim 20, Rivette discloses wherein said graphical collaboration tool includes a collaborative content element name entry field (fig 43, col 11, lines 17-65).

30. As per claim 21, Rivette discloses wherein said web browser software, said graphical collaboration tool, and said server process execute on the same computer system (fig 43).

31. As per claim 22, Rivette discloses wherein said web browser software, said graphical collaboration tool, and said server process each execute on a separate computer system (fig 43 and figs. 5-7I, col 11, lines 17-65).

32. As per claim 41, Rivette discloses graphical collaboration tool is downloaded from a server (fig 43 and figs. 5-7I, col 11, lines 17-65).

33. As per claim 42, Rivette discloses wherein said collaborative content is referencable by a URL (fig 43 and figs. 5-7I, col 11, lines 17-65).

34. As per claim 43, Rivette discloses wherein said graphical collaboration tool includes a client-side scripting language (col 12, lines 33-49).

35. As per claim 44, Rivette discloses wherein said graphical collaboration tool includes at least one of Javascript and dynamic HTML (col 12, lines 33-49).

36. As per claim 45, Rivette discloses wherein said collaborative content includes a URL of the base document and a representation of the collaborative content element (col 11, lines 17-30, col 12, lines 33-49).

37. As per claim 46, Rivette discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to add a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the added collaborative content element (figs. 5-7I, col 11, lines 17-65).

38. As per claim 47, Rivette discloses wherein said graphical collaboration tool, in response to a user manipulating said graphical collaboration tool to modify a collaborative content element, transmits a representation of the collaborative content element and the URL of said collaborative content to a server and receives from the server said collaborative content including the modified collaborative content element (figs. 5-7I, col 11, lines 17-65).

39. As per claim 48, Rivette discloses wherein said graphical collaboration tool includes a toolbar (fig 43).

40. As per claim 49, Rivette discloses wherein the toolbar includes an add circle tool, an add rectangle tool, an add arrow tool, an add text tool, and an add text highlight tool (fig 43).

41. As per claim 50, Rivette discloses wherein the toolbar includes a collaborative content element name entry field (fig 43).

42. As per claim 51, Rivette discloses wherein said collaborative content received from the server includes an HTML page (col 12, lines 33-49).

43. As per claim 52, Rivette discloses wherein said collaborative content received from the server includes an HTML page (col 12, lines 33-49).

44. As per claim 53, the claim is rejected for the same reasons as claim 17, above.

45. As per claim 54, Rivette discloses wherein said collaborative content is referencable by a URL (col 11, lines 17-65).

46. As per claim 55, Rivette discloses wherein said server process is a CGI script (figs. 5-7I, col 11, lines 17-65; col 12, lines 33-49).

47. As per claim 56, Rivette discloses wherein said collaborative content includes a URL of a base document and a representation of a collaborative content element (figs. 5-7I, col 11, lines 17-65).

48. As per claim 57, Rivette discloses wherein said server process executes on a client workstation of a user (figs. 5-7I, col 11, lines 17-65).

49. As per claim 58, Rivette discloses wherein said collaborative content transmitted in response to a user request includes an HTML page (col 12, lines 33-49).

50. As per claim 59, Rivette discloses transmitting between said originator client workstation and at least one receiver client workstation a document identifier having said rendering instructions embedded therein and comprising said collaborative content (see discussion of Com Object, fig 7A-7I, col 14, lines 58-67).

51. As per claim 61, Rivette discloses of annotating said collaborative content by adding another collaborative content element by said at least one receiver client workstation (col 7, lines 45-67, col 22, lines 1-15).

52. As per claim 62, Rivette discloses the document identifier comprises a Universal Resource Locator (URI) (col 11, lines 15-40).

53. As per claim 63, Rivette discloses the document identifier comprises a Hypertext Markup Language (col 12, lines 12, lines 33-57).

54. As per claim 64, claim is rejected for the same reasons as claim 63, above.

55. As per claim 65, Rivette discloses adapted for transmitting the collaborative content and rendering instructions therefore between client workstations (elements of fig 5, col 7, lines 45-67, col 8, lines 1-12).

56. As per claim 66, Rivette discloses the client workstations transmit collaborative content and rendering instructions via a server (the limitation is satisfied by using COM compliant application using Object Linking Embedded, and, fig 5, fig 7A-7f, col 7, lines 45-67 and col 8, lines 1-12).

### ***Response to Arguments***

57. Applicant's arguments with respect to claims 1-14 and 16-65 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

58. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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59. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Siddiqi whose telephone number is (571) 272-3976. The examiner can normally be reached on Monday -Thursday.

**NATHAN J. FLYNN**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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